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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,108	01/08/2001	Jorg Bruss	027559-039	5345
27045	7590	06/03/2004	EXAMINER	
ERICSSON INC. 6300 LEGACY DRIVE M/S EVR C11 PLANO, TX 75024			NGUYEN, TU X	
			ART UNIT	PAPER NUMBER
			2684	14

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/755,108

Applicant(s)

BRUSS, JORG

Examiner

Tu X Nguyen

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 17-19, 33 and 34 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 and 20-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 17-19, 33 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. Applicant's arguments with respect to claims 1 have been considered but are moot in view of previous rejection.
2. Applicants argue that "Mapping" is not the same as the term "calculating". In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., argument page 11 "The limit calculation unit LCU 210 then calculate the actual limit...in the serving network storage unit MSU and the limit information provided by the UE") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argue, page 12, Lopes-Torres does not disclose determining bearer limit information associated with an RNC or BSC. The examiner disagree, bearer limit information, in light of specification page 5 lines 5-6, which is transfer mode, transfer rate, user protocol (see col.17 line10 through col.18 line 50) and to handle mobile originating and terminating calls, a base station controller BSC (RNC) is a node that control various base transceiver stations and perform radio network management which is reads on claim limitation "associated with RNC".

Applicant argue, page 13, Lopes-Torres fails to disclose "maximum number of bearers". The examiner interprets "number of sets of bearer" broadly meaning more

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than one that reads on "maximum". Because applicants do not clarify a specific number or some kind of comparison in term of maximum.

In response to applicant's argument, page 13 claim rejection under 103(a), that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Lopez Torres and Spartz et al. are in the same field of endeavor, they are wireless signaling transportation and processing speech calls and data, GSM network, channel management.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-10, 12-13, 17-19 and 33-34, are rejected under 35 U.S.C. 102(e) as being anticipated by Lopez Torres (US Patent 6,144,647).

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Regarding claim 1, Lopez Torres discloses a method for exchanging multicall capabilities between user equipment and a network in a radio communication system comprising the steps of:

receiving, from said user equipment to said network, bearer limit information associated with said user equipment (see col.17 lines 20-50, in-light of specification page 5 lines 5-6, user protocol, transfer mode, transfer rate corresponding to "bearer limit information");

calculating, in said network, multicall limit information based on said bearer limit information associated with said user equipment and multicall information associated with said network (see col.10 lines 40-54, "mapping" corresponds to "calculating"); and

returning, to said user equipment, said multicall information (see col.17 lines 50-61).

Regarding claim 2, Lopez Torres discloses said network includes a mobile switching center and a radio network controller, each of which perform functions associated with radiocommunication support of said user equipment (see col.2 lines 27-57), said method further comprising the steps of:

determining bearer limit information associated with said RNC (see col.2 lines 45-57, "BSC" corresponds to "RNC"); and

Using said bearer limit information associated with said RNC to calculate said multicall limit information (see col.17 lines 1-67).

Regarding claims 3 and 19, Lopez Torres discloses receiving an indication of a maximum number of bearers supported by said user terminal (see col.12 lines 16-25), "number of sets of bearer capabilities" reads on "maximum number".

Regarding claim 4, Lopez Torres discloses receiving a value associated with at least one parameter from which a maximum number of bearers supported by said user terminal can be determined (see col.16-17).

Regarding claims 5 and 8, Lopez Torres discloses transmitting said bearer limit information associated with said RNC for storage in an RNC limits storage unit (see col.2 lines 26-67).

Regarding claim 6, Lopez Torres discloses said RNC storage unit is collocated with said MSC (see fig.2).

Regarding claim 7, Lopez Torres discloses storing said multicall limit information in a storage unit within said user equipment (see col.15 lines 24 through col.16 line 25). It is inherently that the mobile station comprising storing unit in order transmit and negotiating to network of its mobile identification service and mobile bearer capability information.

Regarding claims 9-10 and 12-13, Lopez Torres discloses receiving said bearer limit information after the transmission of a location updating request message (see col.2 lines 31-42).

Regarding claims 17-18, Lopez Torres discloses everything as claim 1 above. More specifically, Lopez Torres discloses "determining a change in said multicall

capabilities has occurred in said user equipment" (see col.17 lines 50-60), "negotiation number of mobile bearer capabilities" reads on "change".

Regarding claim 33, Lopez Torres discloses a computer program in a node of a radiocommunication system (see col.2 lines 42-43).

Regarding claim 34, Lopez Torres disclose a computer program in user equipment (see col.17 lines 50-60 and col.13 lines 1-5). It is inherently the mobile station is computer program in capable functions such as simultaneously transfer data and speech.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez Torres and further in view of Spartz et al. (US Patent 6,178,337).

Regarding claim 11, Lopez Torres fails to disclose CLASSMARK 2 information in location updating request message.

Spartz et al. disclose CLASSMARK 2 information in location updating request message (see col.16 lines 40-45 and col.24 lines 24-30). Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Lopez Torres with the above teaching of Spartz et al. in order to provide negotiation interface CDMA wireless service and GSM networks.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tu Nguyen whose telephone number is (703) 305-3427. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MAUNG NAY A, can be reached at (703) 308-7749.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2600 Customer Service Office at (703) 306-0377.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal

Drive, Arlington. VA., Sixth Floor (Receptionist).

TN
May 25, 2004

Quochien B. Vuong 5/31/04

**QUOCHIEN B. VUONG
PRIMARY EXAMINER**